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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,745	08/18/2000	Robert A. Rosania	9567-3	7327

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AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

REDDICK, MARIE L

ART UNIT PAPER NUMBER

1713

DATE MAILED: 09/11/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/641,745

Applicant(s)

ROSANIA ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/20/00;12/6/00;12/11/00;5/10/02;9/5/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 20-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 & 7. 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the claimed invention: a) the instant carrier vehicle(see claim 6); b) the instant solvent system(see claims 14 and 15); c) the instant NI absorbing agent(see claims 5 and 17).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-19 are generic. Applicant is required to elect an ultimate species of each of components a), b) and c) for further prosecution on the merits.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Election/Restrictions***

2. Applicant's election with traverse of the Group I invention in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the Examiner has failed to meet the requisite legal burden of showing that, in each situation, the inventions are unrelated and therefore, the restriction is improper. This is not found persuasive because it is urged and maintained that the claims as grouped are patentably distinct, each from the other, as per reasons set forth in the previous Office Action (paper no.8, 07/16/02). Further, the Group I invention and the Group II invention are related as product and process of using. In the instant case, the Group I invention can be used as an intermediate in an ink formulating process. The Group I invention and the Group III invention are related as mutually exclusive species in an intermediate-final product relationship. The intermediate product (Group I invention) has utility other than that of the Final product (Group III invention) such as an ink intermediate. Presumably a reaction takes place upon deposition of the composition upon the substrate and evaporation of the solvent engendering a final product substantially different from the intermediate product, i.e., the liquid composition loses its identity upon deposition to the substrate. The process of the Group II invention and the process of the Group IV invention are related as mutually exclusive species, each not requiring the particulars of the other for patentability. Note that the process of the Group IV invention does not require a NI absorbing agent nor a solvent system, as does the Group II invention. The final product resulting from the Group II invention and the final product resulting from the Group IV invention are substantially different. To this end, claims

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20-29 remain withdrawn from consideration by the Examiner as per having been drawn to a non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

***Information Disclosure Statement***

3. The information disclosure statement filed 12/06/00 & 05/10/02 have been carefully considered and placed in the application file.

***Claim Rejections – 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ A) The recited "based on the total weight of the composition" per claim 1 constitutes indefinite subject matter as per it not being readily ascertainable if such is intended to qualify the solvent system only or are the other components also included.

1/2 K B) The recited "selected from" per claim 6 constitutes indefinite subject matter as per the use of improper Markush terminology. Use of "selected from the group consisting of" is proper and is suggested.

K C) The recited "derivatives thereof" per claim 6 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope.

K D) The recited "molecular weight" per claim 10 constitutes indefinite subject matter as per it not being readily ascertainable as to the type of molecular weight intended, i.e., "weight average" or "number average", the two being substantially different. Refer to Ex parte Simpson(61 USPQ2d 1009).

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- K E) The recited "dimethylaminoethylmetacrylate" per claims 12 and 19 should read "dimethylaminoethylmethacrylate".

***Drawings***

6. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haldankar(U.S. 5,998,535).

Haldankar discloses and exemplifies near infrared surface coating compositions defined basically as containing a) from about 1 to about 80 wt.% of a pigment component(sufficient to meet the claimed NI absorbing agent, b) from about 10 to about 60 wt.% of a polymeric dispersant derived from acrylic monomers(sufficient to meet the claimed carrier vehicle component), c) about 5 to 50 wt.% of liquid carrier which includes organic solvents(sufficient to meet the claimed solvent system), d) about 5 to 70 wt.% of a film forming resin which includes acrylic, alkyd and urethane resins and d) other conventional additives which include, extender pigments, wetting agents, flow control agents, plasticizers, etc. See, e.g., the Abstract, cols. 1-7 and the Runs of Haldankar. Haldankar therefore anticipates the instantly claimed invention, in both content and character.

As to the dependent claims, the limitations are either disclosed by Haldankar, suggested by Haldankar or would have been obvious to the skilled artisan and with a reasonable expectation of success.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of

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paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-19 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oi et al(U.S. 5,788,914), Hattori et al(U.S. 6,051,361) or Akiyama et al(U.S. 6,136,425).

Each of Oi et al, Hattori et al and Akiyama et al disclose and exemplify near infrared liquid coating compositions defined basically as containing a) a near infrared absorbing agent, a carrier vehicle which includes at least an acrylic polymer, c) a solvent system and d) other conventional ingredients, not precluded by the instant "comprising" language. Oi et al, Hattori et al and Akiyama et al therefore anticipate the instantly claimed invention, in both content and character. See, e.g., the Abstract, cols. 12-13 and the Runs of Oi et al, the Abstract, cols. 7-16, cols. 35-43 and the Runs of Hattori et al and the Abstract, col. 17, cols. 27-29 and the Runs of Akiyama et al.



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As to the dependent claims, the limitations are either disclosed by patentees, suggested by patentees or would have been obvious to the skilled artisan and with a reasonable expectation of success.

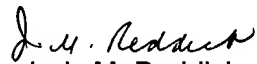
***Conclusion***


13. Note the attached FORM PTO-892 for additional prior art cited as of interest in teaching copolymers which overlap in scope with the copolymers of the claimed invention used as the carrier vehicle and considered merely cumulative to the prior art supra.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
September 6, 2002